

Attorney's Docket No. 004900-174
Application No. 09/486,343
Page 2

REMARKS

Claims 66-175 are pending in the Application. Further to the Request for Reconsideration filed on May 5, 2004, Applicants respectfully request reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the following further remarks.

First, concerning the rejection of Claims 66-117 and 147-175 under 35 U.S.C. § 102(b) as being anticipated by Tirpak (U.S. Patent No. 5,300,556), Applicants provide the following remarks.

Applicants again request that the 102(b) rejection over Tirpak be reconsidered and withdrawn because Tirpak does not expressly or inherently describe each element of the claims of issue. See Kalman v. Kimberly-Clark Corp., 218 U.S.P.Q. 789 (Fed. Cir. 1983).

In particular, Applicants wish to reiterate that there is no disclosure in Tirpak of an "isocyanate composition being gradually added to a stock containing at least some of the aqueous phase and at least some of blocking agents so that the content of free isocyanate functions is equal to not more than two equivalents per kilogram is the isocyanate phase," as recited in independent Claim 66. In addition, Tirpak fails to expressly or inherently describe a process for preparing an oil-in-water emulsion of blocked (polyisocyanate), wherein such process comprises conducting a one-step emulsifying-and-blocking reaction by placing and isocyanate composition comprising free isocyanate functions in contact with at least one blocking agent A in the presence of a surfactant B and an aqueous phase, as set forth in independent Claim 66.

Attorney's Docket No. 004900-174
Application No. 09/486,343
Page 3

For at least these reasons, and those previously set forth in the response filed on May 5, Applicants submit that Claims 66 and 155 are patentable over Tirpak because Tirpak fails to expressly or inherently describe each and every element of Claims 66 and 155. The remaining claims (Claims 67-117, 147-154 and 156-175) all depend, directly or indirectly, from independent Claim 66 or 155, and are therefore also patentable over Tirpak for at least the reasons that Claims 66 and 155 are patentable. Applicants respectfully request reconsideration and withdrawal of the § 102(b) rejection over Tirpak.

In addition, with respect to the rejection of Claims 66-175 under 35 U.S.C. § 103(a) as being unpatentable over Tirpak in view of Yasuda, (EP 367667), Applicants provide the following further remarks.

Applicants submit that it is highly unlikely that one of ordinary skill in the art would have been motivated to combine the preparation of blocked polyisocyanates described in Tirpak with the preparation of phosphoric-acid-modified polyols described in Yasuda. For instance, Yasuda fails to disclose or suggest any emulsion or any blocking reaction in relation to a polyisocyanate phase. In addition, there is no indication in Yasuda of the use of water. Instead, Yasuda only discloses the use of organic solvents. Thus, unlike the process of Claim 66, Applicants submit that Yasuda does not disclose any reactions where an aqueous phase is present.

If there were water in the reaction media of Yasuda, Applicants submit that hydrolysis of the epoxy compounds would occur. Furthermore, the final resin solution obtained in Yasuda is a polyurethane-polyol. Applicants submit that these factors provide further confirmation that water is absent in the reaction media of

Attorney's Docket No. 004900-174Application No. 09/486,343

Page 4

Yasuda. If water were present, one would have expected the formation of ureas and/or biurets, which Yasuda does not disclose.

In addition, even if the phosphorous-containing compounds of Yasuda were similar to those of the present invention, Yasuda does not disclose or suggest using these compounds per se as polyisocyanates-emulsifiers. Thus, for at least this additional reason, Applicants submit that one of ordinary skill in the art would not have been motivated to combine Yasuda with Tirpak in the manner asserted in the Official Action.

In fact, Yasuda is directed to achieving a completely different purpose than that of the present invention. That is, Yasuda first reacts phosphorus-containing compounds with epoxy functions (see Yasuda at page 6, lines 52-58 to page 7, lines 1-2) to obtain a phosphoric acid-modified and epoxy-modified resin. (See Yasuda at page 7, line 37.) Then Yasuda reacts the phosphoric acid-modified and epoxy-modified resin is reacted with a polyisocyanate and polyol to obtain a phosphoric-acid-modified polyurethane-polyol resin solution. (See Yasuda at, for example, Example 14, line 13).

Accordingly, Applicants submit that it is evident that the phosphoric acid-modified- and epoxy-modified resin of Yasuda is completely different from the phosphorus-containing compounds of the present invention. Indeed, Yasuda discloses reacting a phosphoric acid-modified- and epoxy-modified resin with an isocyanate and a polyfunctional hydroxyl compound. (See Yasuda page 2, lines 27-35.) From this disclosure, Applicants submit that one can readily determine that the disclosed reaction takes place between the phosphorus-containing compound and the isocyanate compound. Thus, Applicants submit that Yasuda discloses preparing

Attorney's Docket No. 004900-174Application No. 09/486,343

Page 5

specific polyols, that may contain phosphorus atoms, which then react and attach to isocyanate compounds. In stark contrast, the process of the present invention includes a one-step emulsifying-and-blocking reaction. The claimed one-step emulsifying-and-blocking reaction is very different from that disclosed in Yasuda as set forth, for example, at page 5, lines 7-9, of the instant specification which states, in part, "It is also preferred for the surfactant not to be chemically attached to the isocyanate"

Finally, Applicants submit that Yasuda discloses a "dispersion of magnetic particles." Applicants submit that the disclosed "dispersion of magnetic particles" refers to solid particles which can in no way render obvious the use of the claimed emulsifier for emulsifying an organic phase with an aqueous phase.

In view of the above, Applicants submit that the Official Action has not shown any motivation why one of ordinary skill in the art would have looked to the varying teachings of Tirpak and Yasuda, and combined these teachings to arrive at the claimed invention. Any such motivation clearly can only come from the teachings of the present specification, which teaches the desirability of combining the recited elements. However, the teaching, suggestion or motivation for combining the cited references "cannot come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). That is, the motivation for combining the references cannot be a product of hindsight reconstruction of the claimed invention based on applicant's own disclosure.

Such a hindsight reconstruction has clearly been made in the present Official Action. The Official Action asserts that the claimed invention would have been obvious based on a hindsight selection of claimed elements, as evidenced by the

VA 254341.1

Attorney's Docket No. 004900-174
Application No. 09/486,343
Page 6

inconsistent teachings of the cited references, none of which would suggest to one skilled in the art that the teachings should, or even could, be combined and then further modified to arrive at the claimed invention. Such a combination is improper because the references, viewed by themselves and not retrospect, must suggest the combination asserted in the Official Action. In re Shaffer, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); In re Stoll, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975). Here, the references do not provide any motivation for combining the different elements of the references in the manner asserted in the Official Action. The only motivation for combining the cited references in the manner asserted in the Official Action derives from the disclosure of the present application, which is clearly improper.

For at least the above additional reasons, and those previously set forth in the response filed on May 5, Claims 66, 118 and 155 are patentable over the combination of Tirpak in view of Yasuda. Because the remaining claims (Claims 66-117, 119-154 and 156-175) depend directly or indirectly, from independent Claims 66, 118 or 155, Applicants submit that these claims are also patentable over the asserted combination for at least the reasons that Claims 66, 118 and 155 are patentable thereover. Applicants respectfully request reconsideration and withdrawal of the §103 rejection over Tirpak in view of Yasuda.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

Attorney's Docket No. 004900-174Application No. 09/486,343

Page 7

If there are any questions concerning this paper or the application in general,
Applicants invite the Examiner to telephone the undersigned at the Examiner's
earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 14, 2004By: 

Martin A. Bruehs

Registration No. 45,635

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

VA 254341.1